

### **REMARKS**

Presently, claims 1-35, 37-38, 40-43 and 45-46 are pending in the Application. Initially, Applicant points out that the presently pending claims (unamended) are as shown in the PTO image file wrapper system. Such claims are consistent with the claims as amended in the Article 19 Amendment, filed June 30, 2000, in International Application No. PCT/US99/28629, filed December 2, 1999, of which the present application is a National Stage application. In such Article 19 Amendment, originally filed claims 1-17 were unamended, and new claims 18-46 were added. Based on the PTO image file wrapper, the amendments set forth in the Article 34 Amendment (including the cancellation of claim 37 and amendments to claims 1, 5, 10, 14, 17, 18, 38, 43 and 46), filed February 16, 2001, have not been entered in the presently pending application. **Accordingly, the claim amendments made herein are made with respect to the claims pending in the International Application as a result of the Article 19 Amendment.**

The Abstract has been amended to correct formal errors noted by Applicant and to be consistent with U.S. patent practice. Claims 36, 39 and 44 have been cancelled. Independent claims 1, 5, 10 and 17 have been amended to correct formal errors noted by Applicant. Since these amendments are of a formal nature, no new matter has been added to the application by the foregoing amendments.

### ***Specification***

The Examiner has objected to the specification for failing to contain an Abstract.

Applicant respectfully points out that an Abstract of the Disclosure was submitted with International Application No. PCT/US99/28629, filed December 2, 1999, of which the present application is a National Stage application. Under 37 CFR 1.495(b)(1), upon entering the National Stage, an Applicant need not provide a copy of the International Application if such International Application was originally filed in the USPTO. Accordingly, the Abstract included with the International Application from which the present application was filed, should have been entered in the file wrapper of the present application.

For the Examiner's convenience, Applicant has attached hereto a copy of the Abstract of the Disclosure as filed with the International Application. Additionally, as shown above, Applicant has amended the Abstract to correct formal errors noted by Applicant and to be consistent with U.S. patent practice. Accordingly, no new matter has been added to the application by the amendments to the specification. Reconsideration and withdrawal of the Examiner's objection to the specification are respectfully requested.

### ***Claim Objection***

The Examiner has objected to claim 44 for containing an informality. Specifically, the Examiner argues that in line 3 of claim 44, the word "as" is misspelled and should be changed to "is". Claim 44 has been canceled.

To the extent that the objected-to language appears as part of one or more other pending claims, Applicant respectfully disagrees with the Examiner's objection. The complete claim element reads, "wherein the source code segment for calculating calculates the correlation factor as the scalar product of the ad characterization and the subscriber profile" (emphasis added). Applicant respectfully points out that the claim element is grammatically and syntactically correct as it stands. Therefore, the claim element is proper. Reconsideration and withdrawal of the objection to claim 44 are respectfully requested.

### ***Claim Rejections – Double Patenting***

The Examiner has rejected claims 36, 39 and 44 under 35 U.S.C. §101 as claiming the same subject matter (i.e., statutory double patenting) as claims 19, 21 and 25 of U.S. Patent No. 6,324,519 to Eldering ("the '519 patent").

Claims 36, 39 and 44 have been canceled. Reconsideration and withdrawal of the Examiner's §101, statutory double patenting rejections are respectfully requested.

The Examiner has rejected claims 18-35, 37, 38, 40-43, 45 and 46 under the judicially created doctrine of double patenting as being unpatentable over claims 1-27 of the '519 patent. The Examiner contends that the subject matter claimed in the present application is common to that covered and disclosed by the '519 patent.

Applicant has submitted herewith a Terminal Disclaimer under 37 C.F.R. §1.321(b), stating that the '519 patent and the present application are commonly owned and disclaiming the terminal part of the statutory term of any patent granted on the present application which would extend beyond the full statutory term of the '519 patent. A statement under 37 C.F.R. 3.73(b), showing chain of title of the present application, is also enclosed herewith. Reconsideration and withdrawal of the Examiner's non-statutory double patent rejection of claims 18-35, 37, 38, 40-43, 45 and 46 are respectfully requested.

***Prior Art Rejection – § 102(e)***

The Examiner has rejected claims 1, 5, 9-11, 14, 17-19, 23, 25, 27-30, 32-34, 41-43 and 46 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,285,987 to Roth et al. ("Roth"). Applicant respectfully traverses this rejection.

Roth teaches a system for providing advertisements from a central server to viewers who access web sites. Roth's system includes a web server system that has databases stored therein, bidding agents that compare the characteristics of viewing opportunities to the specifications in proposed bids and that submit bids as appropriate, and bid selection logic that determines which proposed bid to accept for each particular viewing opportunity (or "view-op"). In Roth, each advertiser provides one or more "proposed bids" that specify how much the advertiser is willing to pay for displaying a particular advertisement in response to a view-op with certain characteristics. Each proposed bid can specify a price or amount that the advertiser is willing to pay for the opportunity to display an advertisement, (a) to a viewer who has a particular set of characteristics; or (b) on a web page that meets a particular set of criteria. Each proposed bid is dependent upon or requires the satisfaction of various criteria that must be met in

order for a bid of a particular amount to be submitted. In Roth, when a view-op arises, the bidding agents evaluate the characteristics of the view-op compared to the specifications in proposed bids, and the bidding agents submit bids to the bid selection logic when the specifications' requirements are satisfied. The bid logic then selects the highest bid from the various available bids, and the advertisement specified in the highest bid payment offer is displayed. In general, Roth includes one bidding agent for each proposed bid, and each advertiser may have a bidding agent associated with each ad campaign the advertiser wants to conduct. Advertisers submit a proposed bid to their respective bidding agents for evaluation against view-ops. A bid input system is provided so that bids may be provided to bidding agents from the advertisers.

It should be noted from the foregoing description of Roth that (1) the bidding agents are part of Roth's system; (2) no communication takes place between Roth's system and the advertisers while a view-op is being bid upon; (3) Roth's bidding agents merely determine whether a pre-determined list of requirements is met before placing a bid for a view-op and do not calculate a correlation factor between the view-op and advertisement; (4) in Roth, a fixed and pre-determined bid amount is wagered by each bidding agent for acceptable viewing opportunities, regardless of the quality of the view-op or the correlation with the advertisement to be placed; and (5) there is no causal relationship between the receipt of a successful bid from the advertisers and the transmission of an advertisement to the consumer (*i.e.*, Roth's advertisers periodically input their bids and requirements, and only after it is determined that an advertiser's requirements are met, is the highest-bid advertisement submitted to the consumer).

For a rejection under § 102(e) to be proper, a reference must disclose, either explicitly or inherently, each and every element of the claimed invention. Applicant respectfully submits that Roth does not teach each and every element recited in independent claim 1.

Independent claim 1 recites:

In a networked environment having a plurality of computer systems interconnected for the purpose of instantaneously

transmitting and receiving data, a method for auctioning an advertisement opportunity, said method comprising the steps of:

- (a) providing notification of an advertisement opportunity from a content/opportunity provider computer system, wherein said advertisement opportunity corresponds to an opportunity to transmit an advertisement to a consumer;
- (b) receiving an advertisement characterization from an advertiser computer system, wherein said advertisement characterization corresponds to an advertisement;
- (c) calculating a correlation factor between said advertisement characterization and said consumer in a profiler computer system;
- (d) transmitting said correlation factor to said advertiser computer system; and
- (e) receiving a successful bid for said advertisement opportunity at said content/opportunity provider computer system, wherein said successful bid results in the transmission of said advertisement to said consumer in said advertisement opportunity. (emphasis added)

Roth does not disclose “calculating a correlation factor between said advertisement characterization and said consumer in a profiler computer system.” Roth’s system merely checks that a pre-determined list of criteria are satisfied. As stated previously, Roth teaches only that “each bidding agent 30 evaluates each view-op to determine if the view-op meets the criteria specified in a proposed bid” (see column 4, lines 4-6 of Roth). A correlation factor provides more information than a simple binary inquiry and result as to whether or not a list of criteria is satisfied. As such, Applicant’s system allows for greater variability and flexibility in the bidding process.

Roth also does not disclose “transmitting said correlation factor to said advertiser computer system.” Not only does Roth not teach the calculation of a correlation factor (and, hence, none can be transmitted, because none exists), but also, once a

viewing/advertising opportunity is presented, there is no communication whatsoever (regarding a correlation factor or anything else) between Roth's system and the advertiser's system. As indicated previously:

[Roth's] system sends information regarding the view-op and related information in the database 16B to the bidding agents 30. The bidding agents 30 compare the information about the view-op to the proposed bids that have been submitted [previously] by advertisers. That is, the bidding agents 30 determine if the characteristics of the view-op meet the criteria in the proposed bids, and if so, they submit bids to bid selection logic 16C (see column 5, lines 24-32 of Roth).

Roth's system, therefore, never communicates with the advertiser's computer systems once a view-op is received. For example, Fig. 1 of Roth clearly indicates that the bidding agents 30 are a component of Roth's system, not separate computer systems belonging to the advertisers. Proposed bids, including the bid criteria and bid amount, are input into Roth's system prior to the receipt of any view-op. The bidding agents that correspond to one or more of a given advertiser's advertisement campaigns, are solely responsible for determining whether a bid is to be made, and if so, how much money should be offered. Stated differently, there is no real-time communication between Roth and the advertisers. As such, there is no "transmitting said correlation factor to said advertiser computer system."

Roth does also not disclose "receiving a successful bid for said advertisement opportunity at said content/opportunity provider computer system." Since there is no communication between Roth's system and the advertisers at the time of bid selection, there can be no transmission of a successful bid from the advertisers to Roth's system. As stated previously, the advertisers submit only proposed bids, which are input to bidding agents that act on behalf of the advertisers when view-ops are presented. It is the bidding agents – not the advertisers – that place bids in response to view-ops. A successful bid, therefore, can only come from the bidding agents, which are part of Roth's system. As such, Roth does not disclose "receiving a successful bid. . .at said

content/opportunity provider computer system,” since the bidding agents are already a part of the content/opportunity provider computer system.

Moreover, Roth does not disclose that the receipt of a successful bid “results in the transmission of said advertisement to said consumer in said advertisement opportunity.” It only stands to reason that if Roth does not teach the receipt of a successful bid from an external computer system, it cannot teach a causal connection between the receipt of a successful bid under such circumstances and the transmission of an advertisement to a consumer. Since Roth does not disclose all of the features of independent claim 1, independent claim 1 is believed to be allowable over Roth.

Independent claim 5 recites, “providing notification of an advertisement opportunity from a content/opportunity provider computer system to a plurality of computer systems representing advertisers...; calculating a plurality of correlation factors between said advertisement characterizations and said consumer in a profiler computer system; transmitting said correlation factors to said plurality of computer systems representing advertisers; receiving a plurality of bids for said advertisement opportunity at said content/opportunity provider computer system; ...wherein said successful bid results in the transmission of said advertisement to said consumer in said advertisement opportunity.”

Similarly, independent claim 10 recites, “first means for transmitting an advertisement opportunity announcement;...third means for correlating said advertisement characterization with a consumer profile to produce a correlation result; fourth means for transmitting said correlation result; and fifth means for receiving a bid for said advertisement opportunity.”

Similarly, independent claim 14 recites, “a correlating source code segment for calculating a correlation factor between said advertisement characterization and said consumer characterization; a transmitting source code segment for transmitting said correlation factor; a bid receiving source code segment for receiving a bid for said opportunity; and a selecting source code segment for selecting a successful bid which

results in transmission of said advertisement to said consumer.” For the same reasons discussed above with respect to independent claim 1, Roth does not disclose all of the features recited in independent claims 5, 10 and 14. Accordingly, independent claims 5, 10 and 14 are believed to be allowable over Roth.

Independent claim 17 recites:

A method of characterizing subscribers for subsequent targeting of advertisements, the method comprising the steps of:

- (a) recording a series of subscriber viewing selections;
- (b) creating a subscriber characterization based on the viewing selections and a set of heuristic rules;
- (c) storing the subscriber characterization; and
- (d) allowing access to the subscriber characterization to determine the applicability of an advertisement in conjunction with the sale of an advertisement opportunity. (emphasis added).

Roth does not disclose the use of heuristic rules, and therefore, does not disclose “creating a subscriber characterization based on the viewing selections and a set of heuristic rules.” While the advertisers in Roth may create specifications for proposed bids, the method by which the advertiser’s create the specifications is not the subject of Roth’s invention. As such, Roth does not disclose that advertisers use heuristic rules to create the specifications. Thus, Roth does not disclose all of the features of independent claim 17. Accordingly, independent claim 17 is believed to be allowable over Roth.

Independent claims 18, 38, 43 and 46 each recite features similar to one or more of the features noted above with respect to independent claims 1, 5, 10 and/or 14. Thus, for the same reasons discussed above with respect to independent claims 1, 5, 10 and/or 14, Roth does not disclose all of the features of claims 18, 38, 43 and 46. Accordingly, independent claims 18, 38, 43 and 46 are believed to be allowable over Roth.



Dependent claims 9, 11, 19, 23, 25, 27-30, 32-34 and 41-42 are allowable at least by dependency on independent claims 5, 10, 18 and 38, respectively. Reconsideration and withdrawal of the Examiner's anticipation rejection of claims 1, 5, 9-11, 14, 17-19, 23, 25, 27-30, 32-34, 41-43 and 46 are respectfully requested.

***Prior Art Rejections – § 103(a)***

The Examiner has rejected claims 2-4, 6-8, 12, 13, 15, 16, 26, 31, 35, 36, 39, and 44 under 35 U.S.C. § 103(a) as unpatentable over Roth in view of U.S. Patent No. 6,327,574 to Kramer ("Kramer").

As discussed above with respect to the Examiner's anticipation rejection over Roth, Roth does not disclose all of the elements of independent claims 1, 5, 10, 14 and 18. Without admitting the propriety of the Examiner's combination of Kramer with Roth, Applicant respectfully submits that Kramer does not teach or suggest all of the elements of these independent claims that are missing from Roth. Accordingly, independent claims 1, 5, 10, 14 and 18 are believed to be allowable over the combination of Roth and Kramer. Dependent claims 2-4, 6-8, 12, 13, 15, 16, 26 and 31 are allowable at least by their dependency on independent claims 1, 5, 10, 14, and 18, respectively. Claims 36, 39 and 44 have been canceled. Reconsideration and withdrawal of the Examiner's § 103(a) rejection of claims 2-4, 6-8, 12, 13, 15, 16, 26, 31, 35, 36, 39, and 44 are respectfully requested.

The Examiner has rejected claims 20-22 as being unpatentable over Roth in view of U.S. Patent No. 5,835,896 to Fisher et al ("Fisher"). As discussed above with respect to the Examiner's anticipation rejection over Roth, Roth does not disclose all of the elements of independent claim 18. Without admitting the propriety of the Examiner's combination of Fisher with Roth, Applicant respectfully submits that Fisher does not teach or suggest all of the elements of claim 18 that are missing from Roth. Accordingly, independent claim 18 is believed to be allowable over the combination of Roth and Fisher. Dependent claims 20-22 are allowable at least by their dependency on

independent claim 18. Reconsideration and withdrawal of the Examiner's § 103(a) rejection of claims 20-22 are respectfully requested.

The Examiner has rejected claims 24, 37, 40, and 45 as being unpatentable over Roth in view of U.S. Patent No. 5,974,398 to Hanson et al. ("Hanson"). As discussed above with respect to the Examiner's anticipation rejection over Roth, Roth does not disclose all of the elements of independent claims 18, 38 and 43. Without admitting the propriety of the Examiner's combination of Hanson with Roth, Applicant respectfully submits that Hanson does not teach or suggest all of the elements of these independent claims that are missing from Roth. Accordingly, independent claims 18, 38 and 43 are believed to be allowable over the combination of Roth and Hanson. Dependent claims 24, 37, 40 and 45 are allowable at least by their dependency on independent claims 18, 38 and 43, respectively. Reconsideration and withdrawal of the Examiner's § 103(a) rejection of claims 24, 37, 40 and 45 are respectfully requested.

### ***Conclusion***

In view of the foregoing amendments and remarks, Applicant respectfully submits that the Examiner's objections and rejections have been overcome, and that the application, including claims 1-35, 37-38, 40-43 and 45-46, is in condition for allowance. Reconsideration and withdrawal of the Examiner's objections and rejections and an early Notice of Allowance are respectfully requested.

Respectfully submitted,

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